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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,409	11/03/2003	Jody Shapiro	2500803-991110	5713

7590 01/03/2007  
William S. Frommer  
Frommer Lawrence & Haug LLP  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
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HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/700,409

Applicant(s)

SHAPIRO, JODY

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2006 and prior.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 1-28, 38-51 and 61-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-37 and 52-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040209 et seq.</u> | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> .       |

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1. Claims 29-37 and 52-60 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The Abstract is in error since line 2 should be changed to --code to the user's computer--.
4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup> (i.e., page 2 as an example), and other legal symbols ® (i.e., page 2 as an example), where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. Use of active hyperlink and/or other forms of browser executable code is improper (see MPEP 608.01) and must be removed (see pages 16 and 18 as examples), all others must also be removed). The reason being many OCR softwares will automatically associate (convert) such as an active (clickable) URL. Also, due to the dynamic nature of such links, they tend to become disabled rather than not in a relatively short time compared to the life of a Patent.
6. The applicant argued the 11 May 2006 restriction requirement, in his 31 August 2006 response, by stating in substance that the applicant's representative elects, with traverse, the claims of Group IV. This traversal of the May 11, 2006 restriction requirement is based on the contention here that the claims of Group V should be examined with the claims of Group IV. Stated otherwise, the applicant requests a revision to the May 11, 2006 restriction requirement to join Group V claims 38-50 and claims 61-73 into Group IV. It is respectfully submitted that the claims of Group IV and the claims of Group V are directed to the same invention, claimed, however, from different points of view. Claims 29-37 and 52-60 are directed to remotely determining the configuration of a multi-media computer, but from the vantage point of the remote location. Claims 38-50 and 61-73 are directed to remotely determining the configuration of a multi-media computer, but from the vantage point of the multi-media computer. In all other respects, the two groups of claims are quite similar; compare claim 29 to claim 38, for example. This similarity would impose no burden on the Office to examine all of claims 29-50 and 52-73 together, in one application. However, a transmitter and a receiver are two different inventions. The cap of a jar is different then the jar. Also, the dependent claims of the non-elected group were not covered by the elected group. Thus the restriction requirement of 11 May 2006 is hereby incorporated in this Office Action by reference and continues and made FINAL.
7. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322, 1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).

8. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b). However, no terminal disclaimer can be used to overcome a statutory or provisional statutory double patenting.

9. Claims 29-37 and 52-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 47-65 of United States Patent Application 09/986,683. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 09/986,683 contains every element of this instant application and as such anticipates claims 29-37 and 52-60 of the instant application. Also, since United States Patent Application 09/986,683 is narrower in scope, this application fully encompasses and thus is infringed by United States Patent Application 09/986,683. This is a obvious-type double patenting which may be overcome with a terminal disclaimer.

10. Claims 29-37 and 52-60 are provisionally rejected under the statutory double patenting as being unpatentable over claims 29-37 and 52-60 of United States Patent Application 11/471,909 as claiming the same identical invention. This is statutory double patenting which may not be overcome with a terminal disclaimer.

11. The following is a quotation of the second paragraph of 35 U.S.C 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

12. Claims 29-37 and 52-60 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

- a) "the configuration"--claim 29 (line 1) and clai 52 (line 3);
- b) "the instruction"—claim 31 (line 1), claim 32 (line 1), claim 54 (line 1), and claim 55 (line 1);
- c) "the sending"-- claim 31 (line 1), claim 32 (line 1), claim 54 (lines 1-2), and claim 55 (lines 1-2).

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13. As to 12 (a-c) above, these are but a few examples of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

14. Also the claims recited "sending a modified information header instruction" without clearly defining who is doing the sending and who is doing the receiving.

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

**A person shall be entitled to a patent unless -**

**(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;**

16. **Claims 29-37 and 52-60 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Sahai et al. (United States Patent Number: US 6,594,699 B1).

17. Per claim 29, Sahai et al. taught a method for remotely determining the configuration of a computer of a multimedia content user (e.g., see Title), comprising:

(a) sending player detection code to the user's computer (e.g., see col. 5 (lines 10-46));

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(b) receiving configuration information regarding the user's computer (e.g., see col. 4 (line 5-et seq.)); and

(c) sending a modified information (MIME) header instruction (e.g., see col. 5 (line 67) and/or those implied by col. 3 (line 5-et seq.) since the applied reference was a TCP/IP based system that implemented headers).

18. Per claim 30, since the clients are connected to the servers via the Internet, each client must have a unique IP address per col. 3 (lines 47-49).

19. Per claim 31, claim 32, and claim 33, as best understood by examiner in light of 35 U.S.C. 112, second paragraph issues outlined above, instructions were received after data was sent and the modified MIME information including some information that was not included in the sent information and the modified information excluding some information that was included in the sent information per col. 5 (line 64-et seq.). Also, in addition to the MIME header, the header implemented by the client on returning client configuration, per col. 3 (line 5-et seq.) reads on the limitations as found in claim 33.

20. Per claim 34, claim 35, claim 36 and claim 37, as covered in col. 3 (lines 23-et seq.), the received configuration information included one or more adaptations for either hardware and/or user interface version (i.e., browser) which were prepared in the modified header information sent back to the server. Data sent from client to server had to have headers as this was TCP/IP based networking or viewed in the alternative as the MIME header information indicated above.

21. Per claims 52-60, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

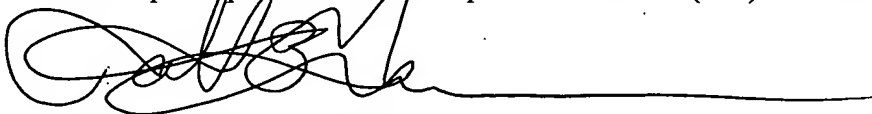
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**22. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'R. Harrell', is written over a horizontal line.

ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142